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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/430,904 11/01/99 WEBB

S 839-636

EXAMINER

MM91/1108

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PEREZ, G

ART UNIT

PAPER NUMBER

2834

DATE MAILED:

11/08/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/430,904

Applicant(s)

WEBB ET AL.

Examiner

Guillermo Perez

Art Unit

2834

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2000.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) _____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

DETAILED ACTION

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1 to 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holter (U. S. Pat. No. 5, 266, 856) in view of Lemelson (U. S. Pat. No. 5, 096, 352).

Holter discloses a dynamo-electric machine (10) comprising a seal casing (12) and an endshield (10), wherein said seal casing and said endshield are secured by a plurality of electrically insulated bolts (20 and column 4, lines 5 to 9), each bolt having a head with a flange and a threaded shank. However, Holter does not disclose that some portion of said shank and the underside of said integral flange have an electrically insulating powder composition coating applied thereto; nor that said coating has a thickness of about 0.004 to about 0.014 in.; nor that said coating remains functional fully tightened and at an electrical potential of about 5000 VDC.

Lemelson discloses that some portion of said shank and the underside of said integral flange (column 3, lines 35-43) have an electrically insulating composition coating applied thereto (column 4, lines 2 to 6); and that

said coating has a thickness of about 0.004 to about 0.014 in (column 6, lines 14 to 24; and that

said coating remains functional fully tightened, for the purpose of increase the strength thereof, protect the surfaces of such fasteners against surface failure during

use, protect the fastener materials against chemical and heat corrosion as well as physical attrition and insulate the fasteners electrically.

It would have been obvious at the time the invention was made to modify the dynamo-electric machine of Holter and provide it with some portion of the shank and the underside of the integral flange having an electrically insulating composition coating applied thereto; and the coating having a thickness of about 0.004 to about 0.014 in.; and the coating remaining functional fully tightened as disclosed by Lemelson, for the purpose of increase the strength thereof, protect the surfaces of such fasteners against surface failure during use, protect the fastener materials against chemical and heat corrosion as well as physical attrition and insulate the fasteners electrically.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to select an electrically insulating powder composition coating, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the coating functional at an electrical potential of about 5000 VDC since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Response to Arguments

Applicant's arguments filed August 23, 2000 have been fully considered but they are not persuasive.

In response to Applicant's argument that "the insulation disclosed in Holter is solely for vibration elimination", the fact that Applicant uses insulation for a different purpose does not alter the conclusion that its use in a prior art device would prima facie obvious from the purpose disclosed in the reference." *In re Lintner*, 173 USPQ 560.

In response to Applicant's argument that "Holter fails to disclose or teach a flanged bolt head", it has to be noted that Lemelson teaches that kind of bolt as described on column 3, lines 35-43: "the fasteners of Figs. 1 and 2 may also contain one or more washers or locking devices secured beneath the head 11 or to the threaded portion thereof". The Applicant acknowledges in the "Background of the invention" section of the application that an "application also includes a metal washer under the bolt head to prevent cracking of the insulation washer." and that "a variation of this design that reduces the number of parts includes a bolt with an integral washer forged with the head, known as flange headed bolt. Merriam-Webster's Collegiate Dictionary tenth edition defines a flange as "a rib or rim for strength, for guiding, or for attachment to another object" which is what Lemelson, and the Applicants are referring with respect to the flanged head bolt.

In response to Applicant's argument that "Lemelson does not relate to a high voltage electrical insulation application", it has to be noted that it is known of the high

voltage electric insulation properties of diamond, which enables it to be used as such insulator in electrical applications.

In response to Applicant's argument that "non of the references "utilize powder coating technology" it needs to be noted the obviousness for one having ordinary skill in the art at the time the invention was made to use a powder coating technology, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. The use of a specific known insulating material is open to obvious selection depending on specific qualities of the material.

In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgement on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2 1392; 170 USPQ 209 (CCPA 1971).

An object of Lemelson is the protection of the surface of the bolts due to friction and the application of specific processes. Holter intends to reduce vibration in the embodiment with the use of neoprene washers, but also the washers may protect the surface of the bolts from vibration and friction, which is one of the objective of Lemelson (column 4, lines 2-15).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to the Notice of References Cited for art related to the claimed invention.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Guillermo Perez whose telephone number is (703) 306-5443. The examiner can normally be reached on Monday through Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nestor Ramirez can be reached on (703) 308 1371. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

Application/Control Number: 09/430,904

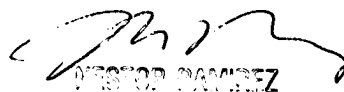
Page 7

Art Unit: 2834

305 3432 for regular communications and (703) 305 3432 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308 0956.

Guillermo Perez
November 2, 2000



GUILLERMO PEREZ
RECEIVED
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